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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,246	03/10/2004	Brian P. Jacob	02420/1200875-US1	3551
7278	7590	02/02/2010	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			SEIVERSON, RYAN J	
			ART UNIT	PAPER NUMBER
			3731	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,246

Applicant(s)

JACOB, BRIAN P.

Examiner

Ryan J. Severson

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) 4-11 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 and 12-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 2, 12-18, 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmed (5,071,408) in view of Makower et al. (5,380,290).**

Ahmed discloses a protection and access device (see figure 11) having an access member (80) having an outer wall, an internal lumen, a sufficiently blunt tip (85), an enclosed cylindrical section (at 84a in figure 11), and a linear slot (86) extending parallel to the axis of the access member. A housing (82) is provided at the proximal end of the access member to help manipulate the access member during surgery. However, Ahmed fails to disclose a window at the proximal end of the slot. Attention is drawn to Makower et al., who teaches a window (36) at the proximal end of a slot in an access member which provides easier access to the lumen of the access member. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included a window in the access member of Ahmed in the manner taught by Makower et al. to provide easier access to the lumen of the access member. Examiner takes the position that the window of Makower et al. extends about 90 degrees around the circumference of the access member.

3. Regarding claim 15, the combination of Ahmed and Makower et al. fails to disclose the length of the window is greater than the length of the slot. However, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). Therefore, it would have been obvious to have sized the window as claimed relative to the slot.

4. Regarding claim 17, the combination of Ahmed and Makower et al. fails to disclose the access member is polymeric, stainless steel, or titanium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the access member of the claimed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. **Claims 3, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmed (5,071,408) in view of Makower et al. (5,380,290) as applied to claims 1 and 20 above, and further in view of Gerrone (5,312,351).** The combination of Ahmed and Makower et al. fails to disclose ports in the housing to allow insufflation gasses to pass there through. Attention is drawn to Gerrone, who teaches the use of ports (20) in a housing member to allow fluid or gas to pass through the

housing into a tubular access member. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included ports on the housing of the combination of Ahmed and Makower et al. in the manner taught by Gerrone to allow fluid or gas to be inserted and/or removed from the surgical site through the access member.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmed (5,071,408) in view of Makower et al. (5,380,290) and Gerrone (5,312,351).

Ahmed discloses a protection and access device (see figure 11) having an access member (80) having an outer wall, an internal lumen, a sufficiently blunt tip (85), an enclosed cylindrical section (at 84a in figure 11), and a linear slot (86) extending parallel to the axis of the access member. A housing (82) is provided at the proximal end of the access member to help manipulate the access member during surgery.

7. However, Ahmed fails to disclose a window at the proximal end of the slot. Attention is drawn to Makower et al., who teaches a window (36) at the proximal end of a slot in an access member which provides easier access to the lumen of the access member. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included a window in the access member of Ahmed in the manner taught by Makower et al. to provide easier access to the lumen of the access member. Examiner takes the position that the window of Makower et al. extends about 90 degrees around the circumference of the access member.

8. Further, the combination of Ahmed and Makower et al. fails to disclose ports in the housing to allow insufflation gasses to pass there through. Attention is drawn to

Gerrone, who teaches the use of ports (20) in a housing member to allow fluid or gas to pass through the housing into a tubular access member. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included ports on the housing of the combination of Ahmed and Makower et al. in the manner taught by Gerrone to allow fluid or gas to be inserted and/or removed from the surgical site through the access member.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 20 and 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J. Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan J. Severson/
Examiner, Art Unit 3731
1/30/10

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
1/31/10